

**REMARKS**

Claims 1–34 were pending in the present application. Claims 1–34 stand rejected. Applicant amends Claims 1, 13, 18, 19, 23 and 31, and adds new Claims 35–42. No new matter is introduced by the amendments. Support for the amendments is found, at least, in Figures 1, 7, 28 and 33 and the description therefor, in addition to pages 10, 13, 14, 15, 18, 21, 22, 26, 27, 31, 32, 39, 40, 41, 43, 44 and 50 of the specification as filed. The amendments for Claims 18 and 31 are to correct clerical errors and are not intended to narrow the claim or to overcome the cited art. Claim 31 has been amended to restore the word “wherein” that was inadvertently deleted in the previous amendment. In light of the amendments and the reasons set forth below, Applicant believes that the present application is in a condition for allowance, for which prompt and favorable action is respectfully requested.

**Discussion of Claim Objection**

Claim 18 was objected to because of an informality. Claim 18 has amended to add the period to the end of the claim.

**Discussion of Rejections Under 35 U.S.C. § 101**

Claims 19–23 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Applicant has amended independent Claims 19 and 13 to add a particular machine or apparatus to certain acts of the method so as to impose meaningful limits on the claim’s scope, and such that the involvement of the machine is not merely insignificant extra-solution activity. Accordingly, Claims 19 and 23, as well as their dependent Claims 20–22, are directed to statutory subject matter under 35 U.S.C. § 101. Therefore, Applicant respectfully requests the rejection of these claims be withdrawn.

**Discussion of Rejections Under 35 U.S.C. § 102(e)**

Claims 1–3, 5, 9–10, and 28–29 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0039948 by Donahue. Applicant respectfully disagrees.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

### **Claim 1**

Amended Claim 1 recites in part:

a real-time feedback generation module configured to receive the analysis data from the performance analysis module and generate the recommendation data based on the analysis data, wherein the computer network interface module receives the recommendation data from the feedback generation module and transmits the recommendation data onto the computer network to a school official, wherein the recommendation data comprises a plurality of courses of action at the level of each class and school.

Applicant has amended Claim 1 to recite “a real-time feedback generation module.” The Donahue reference only discusses real-time in the context of student learning cohorts at paragraphs 0068 (last line) and 0072 (line 10), and where a teacher can provide real-time assistance at paragraph 0083 (last two lines). None of these citations in Donahue describe a real-time feedback generation module.

Regarding “wherein the recommendation data comprises a plurality of courses of action”, the Examiner identified Donahue at paragraphs [0026-0029] as teaching this feature and stated “ ‘A plurality of lesson elements make up a lesson or lesson plan’; i.e. [0026], ‘lesson may include lesson elements including (i) learning how to pronounce the sound that make ... (ii) pronouncing similar sounding words... (iii) identifying the correct...’ ” *Office Action* at pages 3-4. Applicant has amended Claim 1 to recite “wherein the recommendation data comprises a plurality of courses of action at the level of each class and school.” The recommendation data comprising a plurality of courses of actions cited in Donahue are not at the level of each class and school. Applicant has further added dependent Claims 36 and 37 regarding class and school level actions.

For at least the reasons discussed above, Applicant respectfully submits that the Donahue reference does not teach or suggest each and every element of amended Claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection.

**Discussion of Rejections Under 35 U.S.C. § 103(a)**

Claims 4, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of U.S. Patent No. 6,526,258 to Bejar et al. Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue. Claims 7, 8, 13–18, and 30–34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of a Today@UCI press release entitled “Piano Computing and Training . . .” (hereinafter UCI). Claims 19, 20, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of U.S. Patent No. 6,514,084 to Thomas. Claims 21, 22, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of Thomas and in further view of U.S. Patent Publication No. 2004/0033475 by Mizuma et al. Claim 23 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of Thomas, UCI, and U.S. Patent Application No. 2003/0059759 by Calhoun et al.

Applicant respectfully submits that, as stated in the M.P.E.P. at § 2143, “The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (emphasis added). Applicant further submits that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 418. Rather, as stated in the M.P.E.P. at § 2143.01, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 419 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Applicant respectfully submits each of Claims 4, 6–8, 11–27, and 30–34 include an element not disclosed by the prior art.

**Claim 13**

Applicant has amended Claim 13 to recite, in part,

an analysis and feedback module configured to receive the student performance data from the education module and generate feedback data by performing an analysis of the student performance data, wherein the analysis of the student performance data identifies a level of the student's mastery of the subject matter, wherein the levels are 1) mastery of the subject matter has already been obtained, 2) mastery of the subject matter is being obtained, and 3) mastery of the subject matter is not being obtained.

The Examiner has identified paragraph 0047 of Donahue as disclosing the analysis and feedback module. Applicant respectfully submits that neither Donahue nor UCI discloses the three levels of the student's mastery as recited above in the amended claim. Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### **Claims 19 and 24**

Independent Claims 19 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of Thomas. Applicant respectfully disagrees because the cited references fail to teach or suggest all the claimed features.

Claim 19 (and similarly for Claim 24) recites in pertinent part: "extrapolating the best fit curve to determine whether the threshold passing score will be reached within a maximum allotted number of times of taking the quiz." The Examiner has identified column 7, line 57 to column 8, line 30 of Thomas as showing this feature. Thomas describes a way to improve performance on multiple-choice examinations, such as the Multistate Bar Examination (MBE). *Id.* at column 1, line 28. "The questions are preferably presented to the user in sets of questions. Preferably, a set could include about fifteen questions." *Id.* at column 5, lines 54-56. "[O]nce the question set is complete, the learning method 22 is completed, at least for the given question set". *Id.* at column 6, lines 2-3. The cited portion in column 8 describes extrapolating using five different sets of questions. In contrast, Applicant claims "within a maximum allotted number of times of taking the quiz" (emphasis added). In certain embodiments, the student repeats taking the same quiz until certain criteria are met. Neither Thomas nor Donahue disclose extrapolating the best fit curve to determine whether the threshold passing score will be reached within a maximum allotted number of times of taking the quiz. Therefore, Applicant respectfully

submits the cited references fail to teach or suggest each feature in Claim 19 and 24, and as such, respectfully requests withdrawal of these rejections.

### **Claim 23**

Independent Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue in view of Thomas, UCI, and Calhoun et al. Applicant respectfully disagrees as the cited references fail to teach or suggest all the claimed features.

On page 13 of the Office Action, the Examiner indicated that independent Claim 23 does not “distinguish whether the selected ‘appropriate tests’ were deficient or if the learning program (therapy) was deficient.” Applicant has amended Claim 23 to recite in part: “determining that the game is deficient if the game score is not commensurate with the diagnostic quiz score;” and “determining adjustments to the game or the diagnostic quiz based on the comparison of the game score to the diagnostic quiz score if the game is deficient.” The Examiner stated that Calhoun [0072]–[0076] discloses “initial testing may be performed to gauge an individual’s abilities, followed by comparing the individual’s progress to determine a correlation.” *Office Action* at page 11.

Applicant’s Claim 23 recites, in part, three different tests used to develop a computerized game: (1) “a basic spatial temporal test”, (2) testing of “an initially designed game”, and (3) “a diagnostic quiz”. Calhoun discloses “administering a set of initial tests” that are “appropriate tests for the human subject.” *Calhoun* at [0072]. The “initial testing is performed at the same time and in the same location as subsequent testing” to “hopefully minimize random variation.” *Id.* The testing in Calhoun is performed to “measure the efficacy and/or side effects of the therapy.” *Id.* at [0074]. Furthermore, Calhoun discloses “testing . . . with administration of a therapy without testing for initial status” and “testing . . . without administration of a therapy and without including initial testing.” *Id.* at [0078]. Once the “appropriate tests” have been selected, the variation disclosed in Calhoun is directed to “the number of times that testing may be administered.” *Id.* at [0077].

Applicant respectfully submits that Calhoun simply discloses one test, or a single set of tests, which is repeatedly administered before and/or during therapy to determine the efficacy of the medical therapy. Applicant claims, in part, using “a basic spatial temporal test”, testing of

“an initially designed game”, and “a diagnostic quiz”, administered at different times to determine the efficacy of both the “diagnostic quiz” and “the designed game”. In contrast, Calhoun would fail to distinguish whether the selected “appropriate tests” were deficient or if the therapy was deficient.

Therefore, Applicant respectfully submits the cited references fail to teach or suggest each feature in Claim 23, and as such, respectfully requests withdrawal of this rejection.

#### **New Claims**

New Claims 35-42 have been added. The new claims are supported by at least Figures 2, 8 and 33 and the description therefore, Claim 19, and pages 22, 23, 26, 27 and 50 of the specification as filed.

#### **Dependent Claims**

Although Applicant has not addressed all the issues or the dependent claims, Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. The dependent claims are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

#### **No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure,

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including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

### CONCLUSION

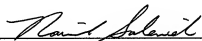
In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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